

**REMARKS/ARGUMENTS**

Claims 1-13 and 27-44 are pending. By this Amendment, claims 1, 5, 9 and 38 are amended. Reconsideration and allowance in view of the above amendments and the following remarks are respectfully requested.

Claims 1-5, 9-13, 34-39, 43 and 44 were rejected under 35 U.S.C. §103(a) over Ho (U.S. Patent 6,435,184). The rejection is respectfully traversed.

Claim 1 recites a CPAP system comprising a mask to be placed over a wearer's face. The mask has a shell, a cushion provided to the shell to sealingly connect the mask to the wearer's face and thereby form a chamber between the shell and the wearer's face, and an inlet port in the shell to receive a flow of breathable gas. The CPAP system further comprises an air flow generator. The air flow generator is mounted on the mask and is capable of generating a pressure of about 2-40 cm H<sub>2</sub>O in the chamber. The air flow generator further comprises an impeller, a motor to drive the impeller, and a housing substantially surrounding at least the impeller.

The Office Action on page 2 alleges that the motor 27 and fan 34 of Ho correspond to the air flow generator including the impeller of the claims. Applicant respectfully disagrees.

As would be understood by one of ordinary skill in the art, an impeller is a rotating component of a centrifugal pump which transfers energy from a motor that drives the pump to a fluid being pumped by accelerating the fluid outwards from a center of rotation. The velocity achieved by the impeller transfers into pressure when the outward movement of the fluid is confined by the housing.

The motor 27 and the fan 34 of Ho do not correspond to the air flow generator of claim 1. The fan 34 is not substantially surrounded by a housing as the fan 34 is provided between the

rear cup body 1 and the front cup body 3 to generate an air flow into the guide way 131 through the inlet 13 into the rear cup body 1. However, as the fan 34 is not substantially surrounded by a housing, the velocity of the air flow generated by the fan 34 is not confined and is not transferred into a pressure. In other words, the fan 34 of Ho is not capable of generating the pressure recited in claim 1.

With respect to the reliance on the rationale used by the court in the precedent of In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955), as noted in the previous response, the facts of that precedent are not sufficiently similar to the facts in the application under examination to permit the Examiner to rely on the rationale used by the court.

In response to Applicant's arguments, the Office Action on page 5 states that Applicant's arguments have been considered but they are not persuasive because, although the Examiner acknowledges that the facts of In re Aller are "somewhat different than the current application," Applicant has failed to provide a sufficient argument of criticality to the claimed pressure range that would preclude the Examiner from applying the already well settled position of optimization set forth in the precedent of In re Aller.

It is respectfully noted that Applicant is not under any requirement to demonstrate any criticality of any particular claimed feature. The determination of obviousness requires a consideration of the claimed subject matter as a whole. There is simply no requirement in 35 U.S.C. §103(a) that the claimed subject matter, as a whole, or any particular claimed feature, be "critically" non-obvious from the prior art. Moreover, with respect to the alleged "well settled position of optimization set forth in In re Aller," the "well settled position" of that precedent is that when the prior art discloses actual values of a particular claimed feature, it is not inventive to discover the optimum or workable ranges by routine experimentation.

As noted in the previous reply, Ho does not disclose the general conditions of claim 1 as Ho does not disclose or suggest any pressure range of the flow generated by the fan 34. As also noted above, as the fan 34 of Ho does not correspond to the impeller of claim 1, Ho is incapable of generating the pressure range recited in claim 1.

As further noted in the previous reply, as set forth in M.P.E.P. §2144.05(II)(B) a particular parameter must first be recognized a result-effective variable, i.e. a variable which achieves a recognized result, before the determination of the optimum or workable ranges of the variable might be characterized as routine experimentation. In the instant case, as Ho does not recognize that the pressure in the chamber formed by the rear cup body 1 is a result-effective variable, optimization of the pressure cannot be determined to be a matter of routine experimentation for one of ordinary skill in the art.

Claim 38 recites a CPAP system comprising a mask configured to cover at least a nasal region of a wearer's face and form an air chamber in communication with the airways of the wearer. The CPAP system further comprises a flow generator provided on an outer surface of a shell of the mask and the flow generator comprises a housing having an air inlet and an air outlet. The flow generator further comprises a motor and an impeller configured to be driven by the motor. The impeller is substantially surrounded by the housing. The flow generator is configured to create a pressure of about 2-40 cm H<sub>2</sub>O in the air chamber.

As discussed above, the fan 34 and the motor 27 of Ho do not correspond to the flow generator of claim 38 as the fan 34 and motor 27 of Ho are incapable of generating a pressure in the range recited in claim 38. Moreover, the fan 34 of Ho is not substantially surrounded by a housing and does not correspond to an impeller.

As noted above, claims 1 and 38 recite a CPAP system. The gas mask structure of Ho, which is capable of filtering out impurities to provide clean air, is not capable of providing any CPAP therapy and cannot be considered a CPAP system. The gas mask structure of Ho is simply a filtering system.

Claims 2-5, 9-13, 34-37, 39, 43 and 44 recite additional features and are allowable for the same reasons discussed above with respect to claims 1 and 38, respectively, and for the additional features recited therein.

Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) over Ho are respectfully requested.

Claims 6 and 40 were rejected under 35 U.S.C. §103(a) over Ho in view of Schlobohm (U.S. Patent 5,154,168); claims 41 and 42 were rejected under 35 U.S.C. §103(a) over Ho in view of Jay (U.S. Patent 6,050,262); claim 8 was rejected under 35 U.S.C. §103(a) over Ho in view of Frater et al. (U.S. Patent 6,772,760); and claims 32 and 33 were rejected under 35 U.S.C. §103(a) over Ho in view of Starr et al. (U.S. Patent 5,517,986). The rejections are respectfully traversed.

The claims recite additional features and are allowable for the same reasons discussed above with respect to claims 1 and 38 and for the additional features recited therein. Moreover, it is respectfully submitted that each of Schlobohm, Jay, Frater et al. and Starr et al. fail to cure the deficiencies of Ho discussed above with respect to claims 1 and 38 and that even assuming it would have been obvious to combine the references, which Applicant does not concede, such combinations would not result in the inventions of claims 1 and 38.

Reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a) are respectfully requested.

In view of the above amendments and remarks, Applicants respectfully submit that all of the claims are allowable and the entire application is in condition for allowance.

The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued pendency of the captioned application.

Should the Examiner believe that anything further is desirable to place the application in condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: /John P. Darling/  
John P. Darling  
Reg. No. 44,482

JPD:tlm  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100